

REMARKS

The Office Action dated February 14, 2006, has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto. Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks.

By this amendment, Claims 1 and 7 have been amended. Thus, Claims 1-12 are currently pending in the application and subject to examination. Applicants submit that the amendments to the claims are fully supported in the originally filed specification, for example, on page 5, lines 12 to 20, page 6, lines 23 to 29, and page 9, line 19, to page 10, line 2 of the specification. Accordingly, Applicants submit that no new matter has been added.

Priority

With respect to the Examiner's comment regarding priority, Applicants note that this application is filed under 35 U.S.C. § 371, and as such a certified copy of the priority document is not required to be filed in the U.S. Patent and Trademark Office in order to claim priority.

Specification

The specification is objected to as containing informalities. The specification has been amended responsive to this objection. Accordingly, Applicants respectfully request withdrawal of the objection.

Objections to the Claims

Claim 1 is objected to as containing informalities. Claim 1 has been amended responsive to this objection. Accordingly, Applicants respectfully request withdrawal of the objection to the claims.

Rejection Under 35 U.S.C. § 112

Claims 1 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action takes the position that Claims 1 and 7 recite features which do not have proper antecedent basis. Claims 1 and 7 have been amended responsive to this rejection. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection Under 35 U.S.C. § 101

Claims 1-12 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. To the extent this rejection remains applicable to the claims currently pending, the Applicants traverse the rejection.

The Office Action appears to take the position that the claims are directed to non-statutory subject matter. The Office Action states that "The claims do not recite an pre- or post-computer activity but merely perform a series of steps of storing, converting, and correcting prices, and is directed to nonstatutory subject matter" (see Office Action, page 3). The Office Action also states that, "While these numbers may be concrete and/or tangible, there does not appear to be any useful result" (see Office Action, page 5). Applicants respectfully disagree.

Under U.S. law, a patent may be granted for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful process thereof.” 35 U.S.C. § 101. With respect to computer related inventions, the Federal Circuit has held that, in order to be eligible for patent protection, the claimed invention must produce a “useful, concrete, and tangible result.” State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998). Applicants submit that the presently claimed invention produces a useful, concrete, and tangible result as required by the statute.

In order to meet the utility requirement, the utility of an invention must be specific, substantial, and credible. M.P.E.P. § 2107. The Office Action admits that “the utility need not be recited in the claims, rather it may be inferred (see Office Action, page 4, sub-paragraph (a)(i)). Applicants submit that the originally-filed specification clearly sets forth the utility of the presently claimed invention, for example, at page 2, lines 6-9, which state, “the objective of the invention is to provide an automatic price correcting system which automatically calculates a price of an article, which has changed because of changes in the specifications of the article.” Applicants submit that, based on this passage and other portions of the disclosure, the utility of the presently claimed invention is well established.

In order to meet the requirements set forth by the Federal Circuit for statutory subject matter, the invention must also provide a “tangible” result. We note that the tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus, or must operate to change articles or materials to a

different state or thing. The Supreme Court has held that “[A]n application of a law of nature or mathematical formula to a... process may well be deserving of patent protection.” Diamond v. Diehr, 450 U.S. 175, 184, 209 U.S.P.Q. 1, 8 (1981).

Claim 1 recites, in part “to correct the standard price stored in the standard price storing section using the correction value of price, and to send the corrected standard price to the computer of the buyer.” Claim 7 recites, in part, “correcting the standard price stored in the standard price storing section using the correction value of price; and sending the corrected standard price to the computer of the buyer.” Applicants submit that these and other elements of the presently claimed invention serve to produce a tangible result as defined by statute and current case law.

Finally, in order to be considered statutory subject matter, the invention must produce a concrete result. In other words, the process must have a result that can be substantially repeatable, or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 U.S.P.Q.2d 1703, 1704 (Fed. Cir. 2000). In the presently claimed invention, among other features, corrects a price, and sends the price to a computer of the buyer. Both the result and the process are repeatable, and if performed under identical conditions, yield identical results. Thus, Applicants submit that the presently claimed invention yields a tangible result.

In summary, Applicants’ claimed invention is useful, tangible, and concrete, in accordance with the requirements set forth in State Street and reinforced by the recent decision In re Lundgren, 76 U.S.P.Q.2d 1385 (B.P.A.I. 2005). As such, Applicants submit that the subject matter recited in Claims 1-12 of the present application constitutes

statutory subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection.

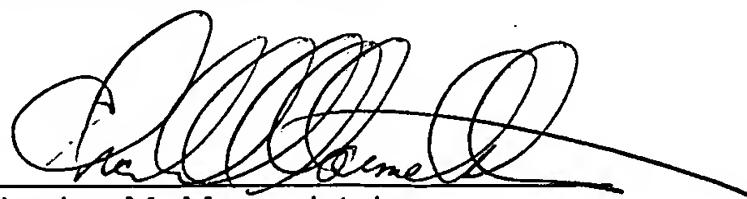
Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding objections and rejections, allowance of Claims 1-12 and the prompt issuance of a Notice of Allowability are respectfully solicited.

If the Examiner believes that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below to schedule a personal or telephone interview to discuss any remaining issues.

In the event that this paper is not being timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 108426-00014.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Charles M. Marmelstein', with a long horizontal flourish extending to the right.

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